

REMARKS

The independent claims have been amended to specify that the modified polyester resin is one containing an isocyanate or epoxy group. Support for this change is found in the specification in the paragraph bridging pages 24 and 25. Minor stylistic changes have been made in a number of other claims. The claims before the Examiner remain Claims 1-42.

The rejection of Claims 1-42 under 35 U.S.C. § 103 as unpatentable over Higuchi et al. (U.S. Patent Application Publication No. 2003/0165760) in view of Sawada et al. (U.S. Patent Application Publication No. 2003/0129518) is respectfully traversed. The Examiner asserts that Claims 1-37 are in essence product by process claims and that the present case is controlled by the holding of the U.S. Court of Appeals for the Federal Circuit in Smithkline v. Apotex 04-1522 of February 24, 2006. Applicants respectfully disagree.

The present invention is directed to an improved toner in which the toner particles are formed of certain specified components and those components are treated in certain ways. Claim 1, for example, states that the modified polyester resin is either dissolved or dispersed in an inorganic solvent to form respectively a solution or dispersion, which in turn is mixed with resin particles in aqueous medium, and the modified polyester resin is then subjected to either crosslinking, elongation or both in the aqueous medium. Thus the toner particles recited in Claim 1 (and other claims) are different from a mere mixture of the recited components because the components have been treated in the way specified in the claims. The process features recited in the instant claims are steps of manipulation of the indicated components rather than steps of manufacturing the components. The toner particles are much more than a mixture of the recited binder resin and colorant. Thus, the claims are different from those before the court in the Apotex case. The general holding there regarding a product indicated to be made by a particular process is still a product, does not apply to the changed material here, and the rejection should be withdrawn.

The rejection also should be withdrawn because both Higuchi et al. and Sawada et al. are not available prior art because all of Higuchi et al., Sawada et al., and the instant application are owned by the same entity, a situation that existed at the time of the present invention. See 35 USC 103(c)(1).

The provisional rejections of Claim 1 for alleged obviousness-type double patenting over Claim 1 of co-pending application nos. 10/706,113 and 10/443,013 are moot in view of the attached Terminal Disclaimer. The rejections should be withdrawn.

The Examiner is thanked for acknowledging receipt of a certified copy of the priority document and for listing references submitted with Information Disclosure Statements.

In view of the foregoing revisions and remarks, it is respectfully submitted that the application is in condition for allowance and a USPTO paper to those ends is earnestly solicited. The Examiner is requested to telephone the undersigned if additional changes are required prior to allowance.

Respectfully submitted,

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Enclosure: Terminal Disclaimer

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